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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,150	01/23/2002	Ed Gancarcik	481340010041	5763

7590 07/01/2005

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EXAMINER

GARY, ERIKA A

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/055,150

**Applicant(s)**

GANCARCIK ET AL.

**Examiner**

Erika A. Gary

**Art Unit**

2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-10 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Pinard et al., US Patent Number 6,647,103 (hereinafter Pinard).

Regarding claim 1, Pinard discloses a personal digital assistant (PDA) enabled telephony system comprising: call control means for implementing telephony functions [fig. 4: refs PC3, 54]; a telephone set connected to said call control means and having a communication port [fig. 4: phone/docking station 1]; a PDA having a user interface for displaying telephony functions to a user, a detector for detecting a selected telephony function, a telephony application for determining a call command based on said selected telephony function, and a communicator for communicating said call command to said communication port [fig. 4: PDA 5]; wherein said telephone set receives said call command and, in response, passes said selected call command to said call control means for implementing said selected telephony function [col. 1: line 62 – col. 2: line 6].

Regarding claim 2, Pinard discloses communication between said telephone set and said PDA is achieved via a protocol implemented via software within each of said telephone set and said PDA [col. 3: lines 50-56].

Regarding claims 3 and 4, it is inherent for protocols to comprise physical layers, an application or network interfaces, and encapsulation layers.

Regarding claim 5, Pinard discloses said telephone set includes communication means for enabling communication between said PDA and a call server [fig. 1].

Regarding claim 6, Pinard discloses said communication between said PDA and said call server is via one of either a TDM or IP based communication network [fig. 1; col. 4: lines 20-21].

Regarding claim 7, Pinard discloses said telephone set includes communication means for enabling communication between said PDA and a network node [fig. 1].

Regarding claims 8 and 13, Pinard discloses the physical layer comprises at least one of a wired interface or wireless interface [fig. 4: refs. 41, 42, 44, 46].

Regarding claim 9, Pinard discloses the wired interface comprises at least one of a serial interface, parallel interface, USB interface, tip and ring interface [fig. 4: refs. 41, 42].

Regarding claim 10, Pinard discloses the wireless interface comprises at least one of an infrared/IrDA interface, radio interface, and cellular interface [fig 4: refs. 44, 46].

3. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Harris, US Patent Number 6,738,643 (hereinafter Harris).

Regarding claim 1, Harris teaches a personal digital assistant (PDA) enabled telephony system comprising: a call control means for implementing telephony functions [inherent]; a telephone set connected to a call control means and having a communication port [fig. 1: ref. 130]; a PDA having a user interface for displaying telephony functions to a user, a detector for detecting a selected telephony function, a telephony application for determining a call command based on said selected telephony function, and a communicator for communicating said call command to said communication port [fig. 1: ref. 100]; wherein said telephone set receives said call command and, in response, passes said selected call command to said call control means for implementing said selected telephony function [fig. 1; col. 1: lines 54-60; col. 2: lines 49-62].

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris.

Regarding claims 11 and 12, the Examiner takes Official Notice that it is well known in the art for a call control means to comprise a PBX or a call server. At the time of the invention, it would have been obvious to one of ordinary skill in the art to include a specific call control means as it is obvious that the telephone set is connected to some type of call control means. The specific call control means used lacks criticality to the overall function of the invention.

### ***Response to Arguments***

6. Applicant's arguments filed February 18, 2005 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., allowing a PDA user to control operation of the telephone system directly from the PDA through the telephone set) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Response to Amendment***

7. The declaration filed on February 18, 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Harris (US Patent Number 6,738,643) reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Harris reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The evidence submitted does not include printed dates preceding the Harris reference.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erika A. Gary whose telephone number is 571-272-7841. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EAG  
June 28, 2005

  
ERIKA A. GARY  
PRIMARY EXAMINER